

REMARKS

This Amendment is being filed in response to the Office Action of April 17, 2009, which has been reviewed and carefully considered. Reconsideration and allowance of the present application in view of the amendments made above and the remarks to follow are respectfully requested.

Claims 1-20 are pending in the Present Application.

In the Office Action, claim 1 is rejected under 35 U.S.C. §112, second paragraph. This rejection of claim 1 under 35 U.S.C. §112, second paragraph is respectfully traversed.

The Office Action states in numbered paragraph 3 that "[t]he limitation, 'if there is no access to the local content title, the server content item can not [be] rendered' is unclear." (See, Office Action, page 2, numbered paragraph 3.) The Office Action takes a position that (emphasis added) "[t]he limitation is unclear and confusing as presented that if local content title is presented on the local content then it may or may not be accessible. If the local content did not have the content title to begin with then there should not be any option for not accessing because it is not presented on the local content therefore, the server content can

not be rendered. Once is it is presented then it is always accessible either locally or pulling additional content from the server."

The discussion of the Office Action obfuscates what is recited in claim 1 and as such, appears to have little to do with recitations of claim 1.

Claim 1 recites in pertinent part "wherein the rendering apparatus presents the stored list of bookmarks to a user and renders a server content item indicated by the server content locator of a user-selected bookmark conditional on having access to a local content title associated with the local content identifier of the user-selected bookmark, wherein if there is no access to the local content title, the server content item can not be rendered."

Accordingly, the discussion of the Office Action as to "[i]f the local content did not have the content title to begin with then there should not be any option for not accessing because it is not presented on the local content ..." has no relevance to the claims.

It is respectfully submitted that claim 1 is definite as presented.

This relevant portion of claim 1 recites in substantial form

presenting the stored list of bookmarks. The list of bookmarks is what the claim recites is presented, not the local content title as alleged in the Office Action.

In effect, the claim provides that a server content item may be rendered (illustrated emphasis provided) "conditional on having access to a local content title" and "if there is no access to the local content title, the server content item can not be rendered."

As clear from claim 1, "the system generates and stores a list of bookmarks ..." So, the list of bookmarks may be presented, yet, this does not guarantee access to the local content title. As perfectly clear from the claim, rendering of the server content item is conditional on having access to the local content title. "[I]f there is no access to the local content title, the server content item can not be rendered."

Accordingly, it is respectfully submitted that claim 1 is definite and it is respectfully requested that this rejection under 35 U.S.C. §112, second paragraph, be withdrawn.

In the Office Action, claim 1 is further rejected under 35 U.S.C. §112, second paragraph. This rejection of claim 1 under 35 U.S.C. §112, second paragraph is respectfully traversed.

The Office Action alleges in numbered paragraph 4 that that (emphasis added) "[i]t is important to note that independent claims 1, 18 and 19, dependent claims 5, 10-14, 16, and 17 are replete with intended use recitations. The claim does not require anything new in that the limitations are "configured to", "according to", "operable to", etc. perform steps that practically any computer can be configured to perform. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art."

This characterization of the claim language is respectfully refuted. The claims do/did not recite intended usage.

In fact, the claims recited claim elements as "operative to ..." which are in fact structural limitations not statements of intended usage.

As recognized (emphasis added) "[a]pparatus claims cover what a device is, not what a device does. An invention need not operate differently than the prior art to be patentable, but need only be (unobviously) different. Therefore, phrases beginning "for performing x. . ." and "can (selectively) be. . ." have not been

given patentable weight. To be given patentable weight in an apparatus claim, a functional limitation must be described in terms of the structure of the device. For example, an apparatus whose functional characteristics are limiting can be "configured to" or "structurally adapted to" perform a specific function." See e.g. Demaco Corp. v. F. Von Langsdorff Licensing Ltd., 851 F.2d 1387, 1390-91, 7 USPQ2d 1222, 1224-25 (Fed. Cir.), cert. Denied, -- U.S. --, 109 S. Ct. 395 (1 988); Panduit Corp. v. Dennison Mfg. Co., 774 F. 2d 1082, 1098, 227 USPQ 337, 348 (Fed. Cir. 1985), vacated, 475 U.S. 809 [229 USPQ 4781 (1 986), on remand, 81 0 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir.), cert. Denied, 481 U.S. 1052 (1 987). Hewlett-Packard Co. v. Bausch & Lomb, Inc., 15 USPQ2d 1525 (Fed. Cir. 1990).

It is respectfully submitted that the language "operative to ..." is language that makes clear that the claim elements perform a specific function and therefore recite structural limitations and not intended usage.

However, in the interest of expediting consideration and allowance of the pending claims, the Applicants have elected to amend the claims to clarify that which is recited in the claims.

By these amendments, the claims are not amended to address issues of patentability and Applicants respectfully reserve all rights under the Doctrine of Equivalents. Applicants furthermore reserve the right to reintroduce subject matter deleted herein at a later time during the prosecution of this application or continuing applications. Accordingly, it is respectfully submitted that claim 1 is definite and it is respectfully requested that this rejection under 35 U.S.C. §112, second paragraph, be withdrawn.

Claim 15 is rejected under 35 U.S.C. §112, second paragraph. This rejection of claim 15 under 35 U.S.C. §112, second paragraph is respectfully traversed. It is respectfully submitted that claim 15 is/was definite as presented.

However, in the interest of expediting consideration and allowance of the pending claims, the Applicants have elected to amend claim 15 to clarify that which is recited in the claims. By these amendments, claim 15 is not amended to address issues of patentability and Applicants respectfully reserve all rights under the Doctrine of Equivalents. Applicants furthermore reserve the right to reintroduce subject matter deleted herein at a later time during the prosecution of this application or continuing

applications. Accordingly, it is respectfully submitted that claim 15 is definite and it is respectfully requested that this rejection under 35 U.S.C. §112, second paragraph, be withdrawn.

In the Office Action, claims 1-8, 10-17, 19 and 20 are rejected under 35 U.S.C. §102(b) over U.S. Patent Publication No. 2002/0078144 to Lamkin ("Lamkin"). Claims 2 and 18 are rejected under 35 U.S.C. §103(a) over Lamkin in view of U.S. Patent Publication No. 2003/0070176 to Parker ("Parker"). Claim 9 is rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Lamkin in view of U.S. Patent No. 7,200,323 to Evans ("Evans"). The rejection of claims 1-20 is respectfully traversed. It is respectfully submitted that claims 1-20, are allowable over Lamkin alone and in view of any combination of Parker and Evans, for at least the following reasons.

In a response to Arguments section of the Office Action starting on page 4, the Office Action takes a position that (emphasis added) "Lamkin discloses that from the stored bookmark a link is provided to access external content upon proper credentials from the local content." This position is respectfully refuted.

The Office Action cites Lamkin, paragraphs [0130] and [0182] in support of this proposition, however, it is respectfully submitted that this portion of Lamkin, nor any other portion for that matter, as the Applicants have carefully considered all of the teachings contained within the four corners of Lamkin, shows what is alleged to be shown.

Lamkin, in paragraph [0130] states (emphasis added):

The command handler (702) controls the DVD/CD navigator (422) including starting and stopping playback, changing audio streams, and displaying sub-pictures from JavaScript, among many things. The command handler (702) provides live web content for non-InterActive disks when an active Internet connection is present through such commands as InterActual.NetConnect() and interActual.NetDisconnect(). The command handler (702) commands the bookmark manager (716) through such commands as InterActual.GotoBookmark() and InterActual.SaveBookmark(). The command handler (702) also interacts with the navigator state module (714) generally regarding user interaction. The Navigator state module (714) keeps the current state of the system and receives it directly from the decoder (or maps directly into it). When the bookmark manager (716) is going to save a bookmark and needs to know the current title, the bookmark manager (716) receives it from the navigator state module (714) and places it in a bookmark and returns it to the command handler to allow it to provide a return value to the InterActual.SaveBookmark command.

Lamkin, paragraph [0130] merely provides that the command handler controls the DVD/CD navigator and provides live web content for non-InterActive disks when an active Internet connection is present. Lamkin paragraph [0130] further provides that the Navigator state module (714) keeps the current state of the system. Lamkin paragraph [0130] also provides that when the bookmark manager (716) is going to save a bookmark and needs to know the current title, the bookmark manager (716) receives it from the navigator state module (714) and places it in a bookmark.

Accordingly, while Lamkin provides for a use of bookmarks including a current title, Lamkin does not teach, disclose or suggest bookmarks that include a server content locator and a local content identifier to link a local content item to a related server content item.

Lamkin, in paragraph [0182] states (emphasis added):

DVDs can be used for multiple user synchronous use. Generally, this is done by having a prearranged time for an event (such information could be programmed on the disk or provided to users from online content accessed via the disk) at which time interested users connect to a prearranged website by use of the appropriate disk. The network site can control all connected devices by sending commands such as play, pause, fast forward, etc. By this manner, content resident on the disks as well as live web-

originated content can be synchronously interwoven for any number of connected users simultaneously. With the server being coupled to the interactive devices the server can send commands to these devices for remotely controlling content stored on local interactive devices connected to a network system, such as the Internet. First, the interactive devices begin with the same interactive content, such as a DVD-Video disk. The interactive devices and a server are adapted to be connected to a network. In operation, information is transmitted from the server to the interactive devices that begin playback of the interactive content utilizing the network. Each interactive device receives the command at the same time and thus the commands and therefore the content are synchronized at start of playback. If the interactive devices support different commands such as a playing at a given time or only playing at a given chapter the server must utilize the supported features for the interactive device and send out only the supported commands to the interactive devices. This allows for the simultaneous playback of the event on each of the client apparatuses. Late synchronization can be achieved by a similar method by sending a command from the server to the interactive devices of the current time position the DVD-Video is playing. For those interactive devices that only support chapter commands the server must wait until the next chapter change to send the command to the interactive device to synchronize with the other interactive devices currently viewing the DVD-Video. Furthermore, this allows content such as DVD Video content to be locked so that play can only be accomplished through verification of interactive devices identity and also allows augmentation and supplementation of the content provided by the video from a remote server. Upon verification of a interactive device's credentials, the locally stored content can be supplemented with additional content delivered over the network system. This is achieved by using precise command sequences from the server to the interactive devices that unlock the local DVD-Video for example.

Lamkin, paragraph [0182] merely provides that DVD content (locally stored content) may be supplemented upon verification of the devices identity and credentials. So while Lamkin does provide for verification to enable playing of local and remote content, However, in Lamkin, it is only verification of the identity and credentials of the device.

In view of the above, Applicants respectfully submit that the claim 1 is not anticipated or made obvious by the teachings of Lamkin. For example, Lamkin does not teach, disclose or suggest a method that amongst other patentable elements, comprises (illustrative emphasis added) "wherein the system generates and stores a list of bookmarks, wherein each bookmark in the list of bookmarks includes a server content locator and a local content identifier to link a local content item to a related server content item; and wherein the rendering apparatus presents the stored list of bookmarks to a user and renders a server content item indicated by the server content locator of a user-selected bookmark conditional on having access to a local content title associated with the local content identifier of the user-selected bookmark, wherein if there is no access to the local content title, the

server content item can not be rendered" as recited in claim 1, and as similarly recited in claims 19 and 20.

Regarding claim 18, it is undisputed that "Lamkin does not expressly disclose wherein the bookmark is presented grayed to indicate that it is not selectable" (See, Office Action, page 12.) Parker is cited to provide that which is admitted missing from Lamkin, however, it is respectfully submitted that reliance on Parker is misplaced.

As discussed above, Lamkin also does not teach, disclose or suggest a "bookmark [that] includes the retrieved server content locator and corresponding local content identifier ..." (See, discussion above.)

Further, Parker in FIG. 4 discussed in paragraph [0057] which is cited in the Office Action, merely describes (emphasis added) "contact block 405 will display available modes of communication with which the user may collaborate or communicate with the contact ... If a particular mode of communication is not available, then a link is not displayed or is displayed in gray (disabled)."

Accordingly, in Parker, if link to a mode of communication is not available, the link may be displayed grayed. It is

respectfully submitted that this has little to do with the claim recitation.

It is also respectfully submitted that the claim 18 is not anticipated or made obvious by the teachings of Lamkin. For example, Lamkin does not teach, disclose or suggest a method that amongst other patentable elements, comprises (illustrative emphasis added) "generating and storing a new bookmark in a list of bookmarks to link the local content item to the related server content item, wherein the new bookmark includes the retrieved server content locator and corresponding local content identifier; and presenting the list of bookmarks, wherein if a bookmark on the list of bookmarks is not selectable, the bookmark is presented grayed to indicate that it is not selectable" as recited in claim 18. Parker merely shows a list of modes of communication including graying out a mode of communication that is not available.

Evans is introduced to allegedly show elements of the dependent claims and as such, does not cure the deficiencies in Lamkin and Parker.

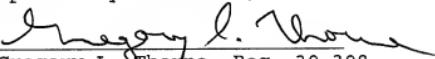
Based on the foregoing, the Applicants respectfully submit that independent claims 1, 18-20 are patentable over Lamkin and

notice to this effect is earnestly solicited. Claims 2-17 respectively depend from claim 1 and accordingly are allowable over Lamkin alone and in view of Evans, for at least this reason as well as for the separately patentable elements contained in each of the claims. Accordingly, separate consideration of each of the dependent claims is respectfully requested.

In addition, Applicants deny any statement, position or averment of the Examiner that is not specifically addressed by the foregoing argument and response. Any rejections and/or points of argument not addressed would appear to be moot in view of the presented remarks. However, the Applicants reserve the right to submit further arguments in support of the above stated position, should that become necessary. No arguments are waived and none of the Examiner's statements are conceded.

Applicants have made a diligent and sincere effort to place this application in condition for immediate allowance and notice to this effect is earnestly solicited.

Respectfully submitted,

By 
Gregory L. Thorne, Reg. 39,398
Attorney for Applicant(s)
July 17, 2009

Please direct all inquiries and correspondence to:

Michael E. Belk, Reg. 33,357
Philips Intellectual Property & Standards
P.O. Box 3001
Briarcliff Manor, NY 10510-8001
(914) 333-9643

THORNE & HALAJIAN, LLP
Applied Technology Center
111 West Main Street
Bay Shore, NY 11706
Tel: (631) 665-5139
Fax: (631) 665-5101